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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,674	02/04/2004	Marc Ira Lipton	8285/671	5600
7590	06/28/2006		EXAMINER	
Peter C. Breen BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			SING, SIMON P	
			ART UNIT	PAPER NUMBER
			2614	

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/772,674	LIPTON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Simon Sing	2614	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 34-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                             | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 34-57 are rejected under 35 U.S.C. 102(e) as being anticipated by Edwards et al. US 5,819,029.

1.1 Regarding claims 34 and 46, Edwards discloses a third party verification system in figure 1, comprising:

a receiver (a telephone interface in the system controller 112) associated with a third party verification (TPV) service to receive, during a telecommunication call, a reply message to confirm an authorized switching to a new long distance service (a telephone service contract inherently is a term and condition contract), or credit and loan processing services (terms and condition contract) (column 9, line 41 to column 10, line 63; column 12, lines 59-67);

a processor (system controller 112) in communication with the receiver;

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a database (IVR response repository 114) in communication with the processor;  
and

wherein the processor creates a record in the database, including audio recordings of affirmative acceptance of the long distance service (column 13, line 66 to column 14, line 23; column 15, lines 27-61).

1.2 Regarding claim 35, Edwards teaches that a spoken reply message indicates an acceptance of a telephone service (column 10, lines 43-55, 61-63; column 12, lines 64-67).

1.3 Regarding claims 36 and 47, Edwards teaches recording a subscriber's identity information (column 14, lines 1-2).

1.4 Regarding claim 37, Edwards teaches indicating a service provide identity (column 10, lines 49-51; column 12, lines 64-67).

1.5 Regarding claim 38, Edwards teaches timing information of a call (column 6, lines 44-46).

1.6 Regarding claim 39, Edwards teaches the identity of a calling party (telemarketer) (column 10, lines 11-15).

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1.7 Regarding claims 40 and 48, Edwards teaches recording a customer's responses to verification prompts (column 10, lines 61-64).

1.8 Regarding claims 41, 49 and 50, it is inherent that by law, a service provider is required to mail a customer a printed copy of terms and conditions of a service contract (see US 3,999,700, column 3, lines 28-33).

1.9 Regarding claims 42 and 51, Edwards teaches a verbal service message (column 10, lines 49-51; column 12, lines 64-67).

1.10 Regarding claims 43 and 52, Edwards teaches a long distance telephone service (column 10, lines 49-51; column 12, lines 64-67).

1.11 regarding claims 44 and 53, Edwards teaches a voice call initiated by telemarketer (column 9, lines 41-51).

1.12 Regarding claim 45, Edwards teaches conferencing a telemarketer with the verification process, and in that the telemarketer may speak to the customer on intervene at any time (column 10, lines 24-28).

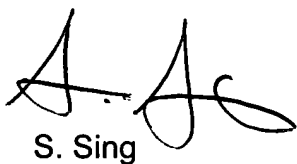
1.13 Regarding claims 54-57, Edwards teaches prompting a customer to say 'yes' or 'no' to a long distance telephone service (column 12, lines 64-67).

***Response to Arguments***

2. Applicant's arguments with respect to claims 34-57 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

3. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Simon Sing whose telephone number is 571-272-7545. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.



S. Sing

06/21/2006



**WING CHAN  
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